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EXAMINER
NGUYEN, TAN D

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 21

Application Number: 09/533,904
Filing Date: March 21, 2000
Appellant(s): KETTUNEN, AUVO K.

Bryan H. Davidson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/29/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 47-53 may be grouped and stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections Based Upon Recapture

Claims 47-53 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp.* v. *United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

> The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In application 08/736,112, which matured into U.S. Patent 5,779,856, applicant amended claim 16 to include the limitation in step (e) that the spent second (2nd) cooking liquor possessed an effective alkali concentration of greater than about "20 g/l". Similarly, claim 16 was also amended to recite the limitation that during at least the last fifteen minutes of step (e), the effective alkali concentration is between "20-40 g/l, so as to produce chemical pulp having enhanced intrinsic fiber strength compared to if the effective alkali concentration was below 15 g/l during the last fifteen minutes of step (e)". Both of these amendments to claim 16 were made to overcome the rejections involving US Patent 5,522,958 to Li. See the amendment of November 12, 1997, page 10, first and second paragraphs. Newly added claim 47, however, does not include these limitations which applicant presented in application 08/736,112 to overcome the prior art of record. Thus, applicant is attempting to recapture subject matter which was surrendered in application 08/736,112.

(11) Response to Argument

Applicant's arguments with respect to the 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based is not persuasive since the subject matter of claim 16 of the original 5,779,856 patent is pertinent to the subject matter claimed by new claim 47 and the comparison is proper.

Applicant's comment that claims 47 and 48-53 dependent thereon do not address the EA concentration of any spent cooking liquors but recite the difference in the EA concentration between the cooking liquors at two different cooking zones is noted however, this difference in the EA concentration is shown on step (d) of claim 16 and the results of step (e) is apparently due to the condition of the first and second cooking liquor as indicated above. Note that the orginal (not amended) claim 16 is fairly taught by US patent 5,522,958 (Li) as shown on Fig. 3 and it appears that the claim was amended to overcome the rejection over Li.

As for the argument that the claims at issue here are narrower in some respect and broader in some other respect, it's the examiner's position that this issue is not germane since they are not related to the issue of recapture.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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dtn
July 12, 2002

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